



IFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Thorsten HEINZEL et al.

Examiner: AEDER, Sean E.

Serial No.: 10/528,104

Group Art Unit: **1642**

Filed: September 28, 2005

Title: **THE USE OF MOLECULAR MARKERS FOR THE PRECLINICAL AND CLINICAL PROFILING OF INHIBITORS OF ENZYMES HAVING HISTONE DEACETYLASE ACTIVITY**

RESPONSE TO RESTRICTION REQUIREMENT

MAIL STOP AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Restriction Requirement dated September 18, 2006, Applicants hereby elect with traverse Group I (Claims 1–17), drawn to a method for characterization of an HDAC inhibitor or a potential HDAC inhibitor.

To satisfy the election of species requirement, Applicants further elect HDAC-2 protein among the species of “molecular markers,” colon cancer among the species of “disease or disorder,” and an antibody directed against HDAC-2 among the species of “means for determining the amount of a molecular marker” as recited at page 3 of the Restriction Requirement.

Withdrawal of this restriction requirement is respectfully requested. At page 2 of the open Office Action, the Examiner alleges that the inventions of Groups I-II have a unique technical feature which is not shown by the other groups. Applicants respectfully disagree with this contention. All the claims in the application involve related subject matter, for example, a method for characterization of an HDAC inhibitor or a potential HDAC inhibitor, as recited in Applicants' elected Group I. A search of all the claims would comprise overlapping subject matter, and it would not be an undue burden on the Examiner to carry

out a search. "If search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct invention." (Emphasis added.) M.P.E.P. § 803.

In the instant application, Applicants courteously submit that Group II (claims 18-20, drawn to a diagnostic kit) should be examined with elected Group I as it is submitted to be little if any additional burden to examine the two groups together. Accordingly, the Examiner is respectfully requested to withdraw the Restriction Requirement in its entirety.

Should the Restriction Requirement still be maintained, Applicants will seek reentry of any withdrawn claims once allowable subject matter has been determined.

No fee is believed to be due with this response, however, the Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



Anthony J. Zelano, Reg. No. 27,969
Attorney for Applicants

MILLEN, WHITE, ZELANO
& BRANIGAN, P.C.
Arlington Courthouse Plaza 1, Suite 1400
2200 Clarendon Boulevard
Arlington, Virginia 22201
Telephone: (703) 243-6333
Facsimile: (703) 243-6410

Attorney Docket No.: **LEDER-15**

Date: October 12, 2006